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10/608,587

06/27/2003

James M. Sweet

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07/16/2009

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EXAMINER

HILLERY, NATHAN

ART UNIT

PAPER NUMBER

2176

MAIL DATE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JAMES M. SWEET, STEVEN J. HARRINGTON, RHYS PRICE
JONES, and ANDREAS SAVAKIS

Application No. 10/608,587
Technology Center 2100

Mailed: July 16, 2009

Before Deborah L. Perry, Supervisory Paralegal Specialist, Review Team.
Perry, Supervisory Paralegal Specialist, Review Team.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 4, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF

SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed an Appeal Brief dated August 26, 2008. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

According to 37 CFR § 41.37(c) (v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of Claimed Subject Matter” appearing on pages 5-7 of the Appeal Brief filed August 26, 2008, is deficient because it does not separately map independent claims 1, 16, and 27 to the specification by line and page number. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief

need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

EXAMINER'S ANSWER

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed October 27, 2008, under the heading "Grounds of rejection is not consistent with the grounds of rejection of claims set forth in the last Office action of record, the Non-Final Rejection mailed January 4, 2007. The Examiner must re-state all rejection on appeal. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds that all grounds of rejection are were not re-stated.

Clarification of the record is required for all pending claims on appeal.

EVIDENCE RELIED UPON

The Evidence Relied Upon appendix must also be corrected to include the reference Prince (US 6877002 B2).

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed August 26, 2008, defective, as required by 37 CFR § 41.37(d);
- 2) notify the Appellant to submit a “paper” which corrects the Appeal Brief’s Summary of Claimed Subject Matter under 37 CFR §41.37(c)(1)(v);
- 3) acknowledge and consider any “paper” submitted by Appellant to correct the Appeal Brief;
- 4) vacate the Examiner’s Answer mailed October 27, 2008;
- 5) issue a Substitute Examiner’s Answer setting all Grounds of rejection to be reviewed on appeal and to correct any other sections (Evidence Relied Upon) of the Examiner’s Answer as may be required; or
- 6) if appropriate or necessary, to issue a Supplemental Examiner’s Answer, to address any new grounds of rejection. Reminder, any

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Supplemental Examiner's Answer must include the approval of the TC

Director or his/her designee; and

7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DLP/bar

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